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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,574	05/14/2004	Paul A. Manfredi	BUR920030148US1	3573

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EXAMINER	
KARLS, SHAY LYNN	
ART UNIT	**PAPER NUMBER**
1744	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,574	MANFREDI, PAUL A.	
	Examiner	Art Unit	
	Shay L. Karls	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *8,9,15,16 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10-14 and 17-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 May 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/14/04; 8/25/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species: Figure 1 and Figure 3. The species are independent or distinct because the inventions in figure 1 and figure 3 are directed to related inventions of removing static charge from an article. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have materially different designs and are not obvious variants of one another. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 10, 12-14 and 17-18 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an

allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with Morgan Heller on 11/13/06 a provisional election was made with traverse to prosecute the invention of Figure 1, claims 1-7, 10-14, 17-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-9, 15-16 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 10-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawn, IBM Technical Disclosure Bulletin.

Hawn teaches an apparatus for removing contaminants from a surface of an article that may have static electrical charge thereon. The apparatus comprises a cleaning member (line 3, conductive brush) and an electrically conductive path extending from the article to ground when the apparatus is connected to an electrical ground (lines 3-8).

With regards to claim 2, the cleaning member is a brush (line 3).

With regards to claim 3, the brush comprises an electrically conductive material (line 3).

With regards to claim 6, the cleaning member is part of the electrically conductive path (lines 3-4; lines 6-8).

With regards to claim 10, the method of removing contaminants from a surface of an article that may have a static electrical charge comprises the steps of cleaning the surface with a cleaning member (line 3, conductive brush), contacting the article with a conductive member connected to an electrical ground (lines 3-4).

With regards to claim 11, the method further includes that the cleaning member is electrically conductive and the cleaning member contacts the article (lines 3-4, lines 6-8).

With regards to claim 12, the brush contacts the surface of the cleaning member (lines 3-4).

With regards to claim 13, the cleaning member brushes the surface (lines 3-6).

With regards to claim 17, there is a system for removing contaminants from a surface comprising an electronic article having a surface (lines 1-2), a cleaning member configured to remove contaminants from the surface (lines 3-4, conductive brush), an electrical ground (line 3), and an electrically conductive path extending from the article to the ground (lines 3-4).

Claims 1-3, 6, 10-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Binkowski (USPN 3757164).

Binkowski teaches an apparatus for removing contaminants from a surface of an article that may have static electrical charge thereon. The apparatus comprises a cleaning member (11, 12) and an electrically conductive path (13) extending from the article to ground when the apparatus is connected to an electrical ground (col. 3, lines 56-65).

With regards to claim 2, the cleaning member is a brush (12).

With regards to claim 3, the brush comprises an electrically conductive material (col. 3, lines 39-44).

With regards to claim 6, the cleaning member is part of the electrically conductive path (col. 3, lines 58-64).

With regards to claim 10, the method of removing contaminants from a surface of an article that may have a static electrical charge comprises the steps of cleaning the surface with a cleaning member (11), contacting the article with a conductive member connected to an electrical ground (col. 3, lines 56-65).

With regards to claim 11, the method further includes that the cleaning member is electrically conductive and the cleaning member contacts the article (col. 3, lines 39-52).

With regards to claim 12, the brush contacts the surface of the cleaning member (col. 3, lines 48-52).

With regards to claim 13, the cleaning member brushes the surface (col. 3, lines 48-52).

With regards to claim 17, there is a system for removing contaminants from a surface comprising an electronic article having a surface (30), a cleaning member configured to remove contaminants from the surface (11, 12), an electrical ground (col. 3, lines 56-65), and an electrically conductive path extending from the article to the ground (13).

Claims 1-4, 6-7, 10-14 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamura et al. (USPN 5508879).

Kitamura teaches an apparatus for removing contaminants from a surface of an article that may have static electrical charge thereon. The apparatus comprises a cleaning member (1) and an electrically conductive path (element 2 and col. 4, lines 1-13) extending from the article to ground when the apparatus is connected to an electrical ground (col. 2, lines 34-37).

With regards to claim 2, the cleaning member is a brush (col. 3, lines 50-53).

With regards to claim 3, the brush comprises an electrically conductive material (col. 3, lines 1-4).

With regards to claim 4, the brush comprises a polymer filled with an electrically conductive material (col. 5, lines 27-31 state that the fibers are made from a polypropylene, nylon or polyester filled with a conductive material such as carbon).

With regards to claim 6, the cleaning member is part of the electrically conductive path (col. 3, lines 58-64).

With regards to claim 10, the method of removing contaminants from a surface of an article that may have a static electrical charge comprises the steps of cleaning the surface with a cleaning member (1), contacting the article with a conductive member connected to an electrical ground (col. 2, lines 34-37).

With regards to claim 11, the method further includes that the cleaning member is electrically conductive and the cleaning member contacts the article (col. 3, lines 1-4; col. 4, lines 17-20).

With regards to claim 12, the brush contacts the surface of the cleaning member (col. 4, lines 17-20).

With regards to claim 13, the cleaning member brushes the surface (col. 4, lines 17-20).

With regards to claim 17, there is a system for removing contaminants from a surface comprising an electronic article having a surface (col. 3, lines 19-20), a cleaning member configured to remove contaminants from the surface (1), an electrical ground (col. 2, lines 34-37), and an electrically conductive path extending from the article to the ground (element 2 and col. 4, lines 1-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura et al. ('879).

Kitamura teaches all the essential elements of the claimed invention however fails to teach that the polymer used is perfluroralkoxyalkane. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use perfluroralkoxyalkane as the polymer for the bristles, since it has been held within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin, 125 USPQ 416.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shay L. Karls whose telephone number is 571-272-1268. The examiner can normally be reached on 7:00-4:30 M-Th, alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slk
11/15/06